



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Anand SUBRAMANIAN, et al.

Art Unit: 3622

Examiner: Raquel Alvarez

For: INTERNET CONTEXTUAL COMMUNICATION
SYSTEM

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37

250.00 OP

Dear Sir:

Appellants submit this brief in accordance with 37 C.F.R. § 41.37 in support of their appeal from the final rejection in the Office Action, mailed July 13, 2005, and the Notice of Panel Decision from Pre-Appeal Brief Review mailed February 27, 2006, in the above-identified patent application.

The present application has been granted special status (See, Decision on Petition to Make Special, mailed April 14, 2004), accordingly, Appellants request accelerated treatment of this brief.

In accordance with the Pre-Appeal Brief Conference Pilot Program, “[t]he time period for filing an appeal brief will be reset to be one month from mailing of the decision on the request, or the balance of the two-month period running from the receipt of the notice of appeal, whichever is greater.” Because the Panel Decision was mailed February 27, 2006, and the Notice of Appeal

was filed January 11, 2006, Applicants submit that they are entitled to one month from the mail date of the decision to file the present Brief with no extension fees (i.e., March 27, 2006). Therefore, Appellants submit that this Appeal Brief is timely filed with the payment of a one-month extension of time fee. However, the Commissioner is hereby authorized to charge any unpaid fees deemed required in connection with this Appeal Brief, or to credit any overpayment, to Deposit Account No. 04-0100.

In accordance with 37 C.F.R. §§ 41.31 and 41.37, this brief follows the January 11, 2006 filing of a Notice of Appeal and payment of the required fee. This brief is in support of said Notice of Appeal.

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is ContextWeb, Inc. The inventors have assigned their rights in and to this application to ContextWeb, Inc., such assignment having been duly recorded.

II. RELATED APPEALS AND INTERFERENCES

To appellants' knowledge, there are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 15, 16, 21, 22 and 27-89 are pending in the application.

This appeal is in respect of the rejection of claims 15, 16, 21, 22 and 27-89.

There are 67 claims pending in the application, *i.e.*, claims 15, 16, 21, 22 and 27-89. They are reproduced in the **Claims Appendix**. The current status of the application's claims is as follows:

1. Claims canceled: none;
2. Claims withdrawn from consideration but not canceled: 1-14, 17-20 and 23-26;

3. Claims 1-14, 17-20 and 23-26 stand withdrawn in response to a telephone Restriction Requirement imposed by the Examiner in charge. The Patent Office Required an election to be made in order to decide whether a Petition to Make Special should be granted.

4. Claims pending: 15, 16, 21, 22 and 27-89;
5. Claims allowed: none;
5. Claims rejected: 15, 16, 21, 22 and 27-89.

Claims 15, 16, 21, 22, 27-31, 33-35, 37-89 stand rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 5,835,087 to Herz et al. (“Herz”). Claims 32 and 36 stand rejected as being unpatentable over Herz in view of the Examiner’s statement of what was known in the art at the time of the invention.

The claims on appeal are claims 15, 16, 21, 22 and 27-89.

For the purpose of the present appeal, Appellants request that claims 15, 16, 21, 22 and 27-89 be considered to form a single group.

IV. STATUS OF AMENDMENTS

An Amendment After Final Action, filed December 13, 2005, included amendments to claims 15, 21, 31, 35, 40, 43, 44, 46, 87 and 89. The amendments to claims 15, 21, 31, 35, 40, 43, 44, 46, 87 and 89 were entered by the Advisory Action mailed January 9, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed invention is directed to systems and methods for delivering advertisements to “a user viewing content by operating a station connected to a distributed computer network.” *See* claim 15, preamble. Independent claim 15 recites that “the station allow[s] the user to retrieve information containing content,” and there is “a data store containing a set of relevancy rules associated with each ad, the rules operable to indicate a level of relevancy of the ad **to the content of the information retrieved [by the user].**” *See* claim 15 (emphasis added). Claim 15 further recites that a matchmaker “parses the content of the information [retrieved by the user] into objects,” and “**targets an ad from the server to the content by applying the relevancy rules in the data store to the objects, free of information about the user.**” The invention then “**sends the targeted ad to the station for display with the content.**” Thus, the claimed invention determines the relevancy of an advertisement in relation to information retrieved by the user (“free of information about the user”), and displays the advertisement together with the content of the retrieved information at the station. Independent claims 21 and 89 recite similar subject matter.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1) Whether claims 15, 16, 21, 22, 27-31, 33-35, 37-89 can properly be rejected as being anticipated under 35 U.S.C. § 102(b) based on the Herz patent.

2) Whether the combination of Herz and the Examiner's statement of what was know in the art at the time of the invention result in the invention of claims 32 and 36 so as to properly reject claims 32 and 36 as being obvious under 35 U.S.C. § 103(a).

VII. ARGUMENT

Grounds of Rejection No. 1

Herz fails to disclose applying relevancy rules to extracted objects in the content of the information retrieved by a user, so as to target an advertisement to the user. Thus, Herz fails to

disclose each and every feature of independent claims 15, 21 and 89. *See supra*, Section V. Therefore, Herz does not anticipate claims 15, 21 and 89, nor their dependent claims.

Herz discloses a system that automatically constructs both a “target profile” for each target object (e.g., a news article, an advertisement, or a coupon) in an electronic media environment, and a “target profile interest summary” for each user. The system then evaluates the target profiles against the user’s target profile interest summaries to determine whether a listing of the article or ad is to be sent to the user. *See Herz*, Abstract. This system operates as a “push” system, meaning that based on a user’s prior interests, Herz pushes a list of news articles or advertisements to the user, which are available for potential viewing by the user. The list is not sent together with any content the user has actively sought. The present invention could be styled a “pull and drag” system — *i.e.*, the user goes on the Internet seeking content which is pulled to his work station. The act of pulling certain content implements the claimed invention with the effect of dragging an advertisement, which is relevant to the pulled content, to the work station for display with the content. *See Amendment After Final Action*, pages 22-23.

The Examiner contends that Herz discloses “that the target profile for the electronic media is based solely on the frequency with [which] the words appear in an article (col. 6, lines 34-46),” and that “[the] first module targets the ads solely on the frequency of the words that appear [in] the article.” *See July 13, 2005 Final Office Action*, item 3, page 3; and item 6, page 5. In the Advisory Action, the Examiner further contends that: “In Herz, a profile for the article is generated and is filtered based on the occurrence/frequency of particular words in the article in order to customize ‘electronic identification of additional objects’ (col. 55, lines 45-67).”

While the Examiner has described Herz’s first module, which generates the “target profile for the electronic media” (e.g., a profile of an advertisement), the Examiner has failed to appreciate that before an advertisement is targeted by Herz’s system, the user’s profile is determined and the target profile is compared to the user profile. In particular, “a profile processing module which estimates each user's interest in various target objects by reference to the users' target profile interest summaries, for example by comparing the target profiles of these target objects against the

the relevancy rules may or may not depend on the content of the ad) compared to objects extracted from “the content of the information retrieved” (“free of information about the user”) and “sends the targeted ad to the station for display with the content.”

Further, Herz fails to disclose the claimed feature of a matchmaker that “directly sends the targeted ad to the station for display with the content,” as recited in independent claims 15, 21 and 89. In the January 9, 2006 Advisory Action the Examiner attempts to show Herz does display the ad with the retrieved content. The Examiner states:

Herz teaches on Figure 10 that based on the news access [sic] by the user, the **list** of news and ads is presented to the users (1104). The ads presented to the users is [sic] based on the information requested by the users and the profile of the article (Col. 56, lines 53 to col. 57, lines 1-10).

Appellants argue that Herz doesn't teach displaying the targeted ads at the station with the content. The Examiner disagrees with Appellants because in step 1103 based on the news accessed by the user and the profile of the article, **a list is presented to the users**, step 1105. (Emphasis added.)

The Examiner's own analysis states that “a list is presented to the users.” Herz clearly discloses “generat[ing] for each user a customized **rank-ordered listing** of target objects most likely to be of interest to that user.” Herz, column 6, lines 56-58 (emphasis added). It is only when the user makes a selection from the list that the article's content is actually received. However, the claimed invention “directly sends the targeted ad to the station for display with the content,” where the “user [is] viewing [the] content by operating a station connected to a distributed computer network.” (Claim 15; *see also* claims 21 and 89.)

Further with respect to Fig. 10, Herz discloses that “[w]hen the user requests access to ‘news’ at step 1102, the profile matching module 203 resident on proxy server S₂ sequentially considers each search profile P_k from the user's search profile set to determine which news articles are most likely of interest to the user.” Herz, column 57, lines 23-27. This process is recursively

executed until articles of interest to the user are identified. Here again, Herz discloses identifying an ad by considering a user's search profile. At step 1104 a list of the identified articles is stored and at a user's request for "news" in general, the list is presented to him. Herz, column 58, lines 27-34 (step 1103 is not identified in the written description). In contrast to "displaying the targeted ads at the station with the content," as recited in the claims, Herz discloses merely presenting a rank-ordered list of possible items for viewing to the user, where the possible items are selected by considering the user's search profile.

In the above-quoted section of the Advisory Action, the Examiner states that the "ads presented to the users [are] based on the information requested by the users," and that step 1103 shows that the list of articles sent to the user is "based on the news accessed by the user." The Examiner's analysis implies that the list of articles is based on the current information retrieved by the user. However, such is not the case and such an operation is not supported by Herz at column 56, lines 53 to column 57 line 10. As described in column 57, lines 11-39, the user logs onto the system and requests suggestions of available content that may be of interest; but, the user does not request any specific content. In response, Herz's system sends the list to the user for consideration. Thus, the user has not retrieved any content, so the list sent to the user is not viewed with content. Further, one cannot read Herz as disclosing that a targeted ad is displayed with the content. Each item in the list is separately selected for viewing by itself.

For the reasons demonstrated above, Appellants submit that Herz does not disclose each and every feature of the claimed invention. Therefore, Herz does not anticipate independent claims 15, 21 and 89, nor their respective base claims.

Grounds of Rejection No. 2

The Examiner's statements of what was known in the prior art merely list (1) monitoring the amount of click-through for an advertisement; and (2) classifying information related to past consumption of prior products or coupons to better target users. Thus, Appellants submit that the

combination of Herz and the Examiner's statements of what was known in the art at the time of the invention fails to result in invention of claims 32 and 36.

Claims 32 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Herz in view of the Examiner's statement of what was known in the art at the time of the invention. Claims 32 and 36 depend from claim 15. The Examiner contends that the subject matter of dependent claims 32 and 36 is "old and well known in the computer related arts." However, the Examiner's Statement does not provide those features of claims 32 and 36 demonstrated above to be missing from Herz with respect to independent claims 15. Thus, the combination of Herz and the Examiner's Statement does not result in the invention of claims 32 and 36. Therefore, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness with respect to claims 32 and 36.

CONCLUSION

For all of the reasons set forth above, the rejections of claims 15, 16, 21, 22 and 27-89 should be reversed. Appellants respectfully request that the application be remanded to the Primary Examiner with an instruction to withdraw the rejections under 35 U.S.C. §§ 102(b) and 103(a), and pass the case to allowance.

Respectfully submitted,

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APPENDIXES

11. (Withdrawn) A method as in claim 5, wherein the station is at least one of a personal computer, a pager, a Web-enabled phone, a personal digital assistant (PDA), a pen-based platform, a wireless digital platform, and a voice-based platform.

12. (Withdrawn) A method as in claim 5, further comprising, the step of:
generating a fee to the service provider each time a service associated with the service provider is presented to the user.

13. (Withdrawn) A method as in claim 5, further comprising the step of:
receiving from the user a selection from the list, the selection being consistent with the navigational goal of the user over the distributed computer network.

14. (Withdrawn) A method as in claim 13, further comprising the step of:
generating a fee to a service provider each time a user selection associated with the service provider is received from the user.

15. (Previously Presented) A system for delivering ads to a user viewing content by operating a station connected to a distributed computer network, comprising:
an ad server which maintains the ads for the user at the station across the distributed computer network, the user station allowing the user to retrieve information containing content;
a data store containing a set of relevancy rules associated with each ad, the rules operable to indicate a level of relevancy of the ad to the content of the information retrieved;
and
a match maker that accesses the content retrieved by the user, extracts that content according to its extracting rules, parses the content of the information into objects, and targets an ad from the server to the content by applying the relevancy rules in the data store to the objects, free of information about the user, and that directly sends the targeted ad to the station for display with the content.

sending targeted services to the user across the distributed computer network.

24. (Withdrawn) A method as in claim 23, wherein the station is at least one of a personal computer, a pager, a Web-enabled phone, a personal digital assistant (PDA), a pen-based platform, a wireless digital platform, and a voice-based platform.

25. (Withdrawn) A method as in claim 23, further comprising the step of:
generating a fee to the service provider associated with the sent targeted service.

26. (Withdrawn) A method as in claim 23, further comprising the step of:
receiving from the user a user selection.

27. (Previously Presented) A system as in claim 15, wherein the targeted ad is presented to the user in at least one of static text, Hyper Text Markup Language, image, Flash, and or rich media format.

28. (Previously Presented) A system as in claim 15, wherein an advertiser has purchased a right to advertise the targeted ads maintained by at least one of the ad server, an ad network, and or an affiliate network.

29. (Previously Presented) A system as in claim 15, wherein the objects parsed by the match maker are at least one of a keyword, a key phrase, or a structural relationship of at least one of multiple keywords, multiple key phrases, a keyword with a key phrase, or multiple keywords with multiple key phrases.

30. (Previously Presented) A system as in claim 29, wherein said at least one key word, a key phrase, and or structural relationship was purchased by an advertiser for targeted advertising.

31. (Previously Presented) A system as in claim 15, wherein the relevancy rules relate to at least one of a keyword, a key phrase or a structural relationship of at least one of multiple keywords, multiple key phrases, a keyword with a key phrase, or multiple keywords with multiple key phrases that was purchased by an advertiser for targeted advertising and wherein the data store stores a price at which said at least one key word, key phrase, or structural relationship was

86. (Previously Presented) The method of claim 64, wherein the advertisement belongs to an advertiser, and wherein identifying targeting information comprises receiving a set of one or more topics from the advertiser.

87. (Previously Amended) The method of claim 64, wherein identifying targeting information comprises applying the relevancy rules in the data store to one or more topics based on the objects parsed from the content.

88. (Previously Presented) The method of claim 64, wherein identifying targeting information comprises generating a set of one or more topics for the advertisement based on text of queries on a search engine that yield a result that links to a web page on a web site to which the advertisement links.

89. (Previously Amended) A system for delivering ads to a user viewing content by operating a station connected to a computer network, comprising:

- a server for storing the ads for delivery to the user operating the station connected to the computer network, the user station allowing the user to retrieve information containing content;

- a memory containing a set of relevancy rules associated with an ad, said relevancy rules operable to indicate a level of relevancy of the ad to the content of the information; and

- a module for accessing the information retrieved by the user, extracting that content based on extracting rules, parsing the content of the information into objects and corresponding attributes, and targeting the ad to the content by applying the relevancy rules in the memory to the objects, free of information about the user, and directly sending the targeted ad to the station for display with the content.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings for this matter.